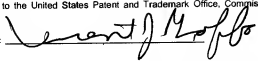


CERTIFICATE OF EFS FILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR §1.8 on the below date:

Date: December 9, 2008 Name: Vincent J. Gropf, Reg. No. 44,714

Signature:



Our Case No. 8285/671

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Marc Ira Lipton, et al.

Serial No. 10/772,674

Filing Date: February 4, 2004

For Method and System for Ordering a  
Telecommunication Service

Examiner: Simon P. Sing

Group Art Unit No.: 2614

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection that was mailed August 29, 2008 in the above-identified application. No amendments to the claims are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

## **I. Introduction**

Claims 34-57 are pending in the application. The Final Office Action of August 29, 2008 maintained the rejection of claims 34-57 under 35 U.S.C. § 103(a) as being unpatentable over Edwards et al. (U.S. Patent No. 5,819,029) in view of O'Neal et al. (U.S. Patent No. 5,887,253).

## **II. The Office Action does not correctly address missing elements of the claims**

Neither reference, alone or in combination, discloses or suggests a call which documents terms and conditions being affirmatively accepted without a service contract, as recited by the claims.

### **A. Claim 34**

Claim 34 recites a system for providing a session for ordering a telecommunication service "wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions, wherein the terms and conditions are accepted without a service contract."

The Office Action is incorrect that Edwards et al. and O'Neal et al. teach verifying, without a service contract, accepting terms and conditions. In both Edwards et al. and O'Neal et al., there is a service contract in place when the terms are verified. The claims, however, recite that terms and conditions of a contract are accepted without a service contract.

Edwards et al. tries to address problems that may occur when a customer switches a long distance service but denies ever having given the authorization to switch the service. Edwards et al. relates to a third party verification system of the service contract that's in place. A customer database manager contacts the customer and, responsive to the customer's authorization to switch a long distance carrier, creates a text file of the customer's responses to a series of questions supporting the authorization to switch the service. The service contract is existing in Edwards et al. when the inquiries occur. O'Neal et al. relates to activating and servicing an existing

cellular telephone service. In step 217, a voice response unit plays recorded messages to the customer concerning the terms and conditions of cellular service, charges and payments, and any other contract provisions which the customer must acknowledge and accept. The voice response unit then instructs the customer to indicate acceptance of the terms and conditions by pressing a key or speaking a specified word or phrase. See Col. 13, ll. 18-25. Therefore, the system of O'Neal also relates to an existing service contract.

Conversely, as stated in the Background of the application, under the tariff system, it is desirable to fully and accurately convey the terms and conditions of an untariffed telecommunication service to a subscriber without requiring the subscriber to sign a service contract. The claims recite that "the terms and conditions are accepted without a service contract." In other words, there is no existing service contract when the terms and conditions are accepted. The processor then "creates a record of the session in the database, wherein the database maintains a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions."

For at least these reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

#### **B. Claim 46**

Claim 46 recites a method for ordering a telecommunication service via a telecommunications call which maintains "a record including a recorded audio representation of at least a portion of the telecommunication call which documents that an individual has affirmatively accepted the terms and conditions contract without a service contract, wherein the maintaining of the record occurs with the use of processor in communication with a database."

As discussed above, the Office Action is incorrect that Edwards et al. and O'Neal et al. teach verifying, without a service contract, accepting terms and conditions. For at least these reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

#### IV. Conclusion

For at least the above reasons, Applicants respectfully request review of the final rejection directed against the current application and withdrawal of the rejections against the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Vincent J. Gnoffo", written over a horizontal line.

Vincent J. Gnoffo  
Registration No. 44,714  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200